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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,557	11/24/2003	Osamu Ikeda	040808-5057-02	1848
9629 7590 04/12/2010 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004				
EXAMINER				
HASAN, SYED Y				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/718,557

Applicant(s)

IKEDA ET AL.

Examiner

SYED Y. HASAN

Art Unit

2621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3 - 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3 - 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/004339.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SI/88)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims pending in the application are 1, 3 - 10, 12, 16, 17, 19 - 26, 28 - 35, 39 - 41, 43 - 48, 50 and 51.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1, 3 – 9 filed on 01/12/2010 have been fully considered but they are not persuasive.

In re page 6 applicant argues with respect to claim 1 that "Mori et al. does not disclose the claimed combination including at least the feature of "an editor ... makes a new moving image file successively; and a recorder compresses and records the new moving image file on the recording medium each time the new image file is made for a predetermined period." In the present invention, the new moving image file is made successively, and each time the new image file is made for a predetermined period, a recorder compresses and records the new moving image file on the recording medium"

In response examiner respectfully disagrees. Mori et al discloses "A preferred embodiment of the authoring encoder EC according to the present invention for generating a new multimedia bitstream MBS by re-encoding the original multimedia bitstream MBS according to the scenario desired by the user is shown in FIG. 2. Note that the original multimedia bitstream MBS comprises a video stream St1 containing the video information, a sub-picture stream St3 containing caption text and other auxiliary video information, and the audio stream St5 containing the audio information." (col 6, lines 39 - 48). This illustrates an editor generating a new multimedia file by re-encoding (compressing) according to scenario desired by user, i.e. for a predetermined period. Furthermore Mori et al discloses "As shown in FIG. 2, the authoring encoder EC comprises a scenario editor 100, encoding system controller 200, video encoder 300, video stream buffer 400, sub-picture encoder 500, sub-picture stream buffer 600, audio

encoder 700, audio stream buffer 800, system encoder 900, video zone formatter 1300, recorder 1200, and recording medium M.”(col 7, lines 4 – 12) and “The bitstream encoded by the authoring encoder EC of the present embodiment is recorded by way of example only to an optical disk.” (col 7, lines 13 – 15). This further illustrates scenario editor and an optical disk (recording medium).

Therefore independent claim 1 and its dependent claims 3 – 9 stay rejected.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3 – 6, 8 and 9 are rejected under 35 U.S.C. 102 (e) as being anticipated by Mori et al (US 5854873)

Regarding **claim 1**, Mori et al discloses an image editing apparatus (fig 2, 100, col 7, lines 16 - 26, scenario editor provides scenario to image editing apparatus shown in fig 2) comprising:

a recording medium (fig 2, M, col 7, line 9) stores a compressed moving image file (col 24, lines 8 – 11) and a scenario file (fig 2, st7 and st 39, col 7, lines 27 – 34 and

col 9, lines 51 – 54) wherein the scenario file is formed by recording a replay order or a replay condition of the moving image file with a predetermined file format (col 7, lines 35 – 44, describes the scenario file)

a scenario evaluating circuit reads the scenario file from the recording medium and evaluates the replay order or the replay condition (fig 3, 2100, col 10, lines 47 – 67, scenario selector in combination with apparatus in fig 3 reads scenario file from disk M) and

an editor reads the compressed moving image file from the recording medium, decodes the read moving image file, edits the decoded moving image file in response to the scenario evaluated by the scenario evaluating circuit and makes a new moving image file successively (fig 3, st104 and st101, col 10, line 19 to col 12, line 16 describe creation of the new image file) and

a recorder compresses and records the new moving image file on the recording medium each time the new image file is made for a predetermined period (col 6, lines 39 – 48, col 7, lines 4 – 12 and lines 13 – 15, see argument above)

Regarding **claim 3**, Mori et al further discloses that the scenario file comprises at least one of a replaying speed of the moving image file, a number of repetitions for replaying the moving image file, a replay range of the moving image file, a special effect, and a replay of sound associated with moving image file (col 7, lines 35 – 44 illustrate scenario data st7 used to reproduce the scenario (sequence) intended by the user)

Regarding **claim 4**, Mori et al further discloses wherein the scenario file includes

identification data indicating if other scenario files are recorded as part of the scenario file and wherein the scenario evaluating circuit evaluates the replay order of the moving image files by following the corresponding scenario file in a hierarchical manner based on the identification data (col 7, lines 27 – 34 illustrate the usability of scenario files in allowing the user to edit the title content, implying that the replay order can be controlled and manipulated)

Regarding **claim 5**, Mori et al discloses a manual replay circuit for replaying the moving image files recorded in the recording medium according to an external replay operation (fig 3, 2100, col 10, lines 47 – 55 illustrate an external replay operation by the scenario selector) and a first scenario editor that records a sequence of manual steps as a replay order or replay condition in the scenario file (fig 3, 2300, col 10, lines 60 – 67 illustrate a scenario editor)

Regarding **claim 6**, Mori et al discloses an edit input unit for receiving the editing operation for the plurality of moving image files (fig 2, 200, encode system controller illustrates an edit input unit) and a second scenario making editor for recording a replay order or replay condition as a scenario file based on the editing operation received from the editing input unit (fig 2, 900, system encoder illustrates editor for recording the scenario based file)

Regarding **claim 8**, Mori et al discloses wherein a replay mechanism replays moving image files taken from the recording medium according to the replay order or the replay condition evaluated by the scenario evaluating circuit (fig 3, col 10, line 19 to

col 12, line 23, illustrates the replay mechanism for replaying moving image file from recording medium).

Regarding **claim 9**, Mori et al discloses wherein the recording medium further includes a first recording medium for storing the moving image file and a second recording medium for storing the scenario file (fig 2, st35 and st39 are formatted by video zone formatter and converted to st43. They are then recorded as st45 on the recording medium. Hence both moving image data and scenario files are on the same recording medium)

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori et al (US 5854873) in view of Niida et al (US 6002837).

Regarding **claim 7**, Mori et al discloses all the features of the instant invention as discussed in claim 1 above except for providing a corrector for detecting an inconsistency when the plurality of moving image files is replayed along with the scenario file, and for correcting the inconsistency according to one of a predetermined priority order or an externally input correction instruction.

Niida et al teaches an image reproducing apparatus (Fig. 2) having a corrector for detecting an inconsistency (drop out) when the plurality of image files is replayed and correcting the inconsistency according to one of a predetermined priority order or an external input correction instruction (Fig. 2 and column 4, line 33 to column 6, line 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the drop out correction circuit of Niida et al into the invention of Mori et al in order to increase the quality of the reproducing video signal by correcting the drop out.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Y. Hasan whose telephone number is 571-270-1082. The examiner can normally be reached on 9/8/5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. Y. H. /
04/05/2010

/Thai Tran/

Supervisory Patent Examiner, Art Unit 2621